UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,117	06/20/2005	Laurent Lesenne	PF 030016	8884

24498 7590 06/25/2009

Thomson Licensing LLC
P.O. Box 5312
Two Independence Way
PRINCETON, NJ 08543-5312

EXAMINER	
NELSON, CHRIS A	

ART UNIT	PAPER NUMBER
2193	

MAIL DATE	DELIVERY MODE
06/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,117	LESENNE ET AL.	
	Examiner	Art Unit	
	CHRIS NELSON	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☒ Claim(s) *11 and 13-16* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/20/2005, 10/11/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims **11, 13-16** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claims **11-13 and 15**, the phrases "Preferably designed to", “Preferably implemented using”, and “Preferably intended to be produced by” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims **1-6, 8-10, 11, 14, 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barmettler et al (US 7203940 B2, hereinafter, Barmettler) in view of Chanut (US 2004/0002367 A1).

6. As per **Claim 1**, Barmettler discloses a conditional execution device for the execution of services received via a communication network, comprising:

a. A module for receiving information associated with said services, provided to receive said information prior to the execution of associated services (Column 5, line 60 to Column 6, line 7). The plug-in executor and plug-in installer provide an application identifier, which comprise a file extension, file name, etc. Executing the application to render the media does not happen until a later stage (See figure 5 for overview).

b. A module for checking the local availability of said identified computer programs (Figure 5, #273, #276, and Column 9, lines 25-41). The installation plug-in proceeds to either box 279 or 283, depending on whether the required version of the application is installed.

c. A selective decision module for the execution of services, provided to allow the execution of said services if said computer programs required for said services are available locally (Figure 5, #273, #276, and Column 9, lines 25-41).

d. A module for acquiring computer programs, capable of triggering a download of said computer programs required for said services if said computer programs are not available locally (Figure 5, #283, #286, and Column 9, lines 25-

67). The installation plug-in generates a secure request for transmission, in order to download the application from an application server.

Barmettler fails to disclose an automatic selective decision module for acquiring computer programs, capable of allowing or preventing the downloading of said computer programs required for said services and not available locally, at least according to said information associated with said services. However, the examiner maintains that it was well known in the art at the time of the invention to provide this limitation, as taught by Chanut.

In a similar field of endeavor, Chanut discloses a method of determining whether to download a file or not, based at least indirectly on the file length, in comparison to a known resource. (See figure 3, 0022, 0025-0026, 0028, and 0049). The resource can be, for example, battery power, which corresponds to the amount of time before the device stops functioning (0004).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a decision module that decides whether or not to download the application based a comparison of the time it would take to download the application, and the time remaining before the device ceases to function. The amount of time necessary to download the application would be determined by the length of the file, which would be determined by examining the application identifier. The purpose for doing so would be to ensure that the application will be able to download successfully.

7. As per **claim 2**, Chanut discloses a conditional execution device as applied to claim 1. Chanut further discloses wherein the information associated with said services

includes temporal information relating to the validity of execution of said services (See figure 3, 0025-0026, 0028, and 0049). Temporal information corresponds to the time it would take to download the application, which would be derived using the application identifier. Chanut discloses wherein the selective acquisition decision module is capable of allowing and preventing said downloading at least according to said temporal information (See figure 3, 0022, 0025-0026, 0028, and 0049). The motivation for this combination would be the same as applied to claim 1.

8. As per **claims 3-5**, Chanut discloses a conditional execution device as applied to claim 2. Chanut further discloses wherein the selective acquisition decision module is designed to allow said downloading if said downloading is expected to be completed before predefined instants of said services, extractable from temporal information, and to prevent said downloading otherwise (See figure 3, 0022, 0025-0026, 0028, and 0049). Chanut also discloses wherein the predefined instances are the start and end of validity of execution of the services.

The moment when the download completes is the same moment that execution of the media becomes valid. Therefore, Chanut inherently meets the added limitation of claim 4.

The moment when the device ceases to function due to a low battery is the moment when execution is no longer valid. It would have been obvious to one of ordinary skill in the art to modify the device to prevent downloading if the user will not be able to actually view the media after downloading the application. Doing so prevents needless downloading of content (0004).

9. As per **claim 6**, chanut discloses a selective acquisition decision module, as applied to claim 3. Chanut discloses wherein the module is capable of acquiring downloading times of said computer programs required and not available locally, and thus estimating when said downloading is expected to be completed (See figure 3, 0022, 0025-0026, 0028, and 0049). The motivation for this combination would be the same as applied to claim 3.

10. As per **claim 8**, Chanut discloses a conditional execution device as applied to claim 1. Chanut also discloses a module for acquiring sizes of said computer programs required and not available locally, and the selective acquisition decision module is capable of allowing and preventing said download also according to said sizes. (See figure 3, 0022, 0025-0026, 0028, and 0049). If the download is too large for the device to remain in operation while downloading, the download will not happen. The motivation for this combination would be the same as applied to claim 1.

11. As per **claim 9**, Chanut discloses the conditional execution device as applied to claim 8. Chanut further discloses wherein the selective acquisition decision module is designed to estimate downloading times of said computer programs required and not available locally according to said sizes and local reception capabilities for said computer programs, and to allow said downloading when said downloading allows at least partial execution of said services. (See figure 3, 0022, 0025-0026, 0028, 0036-0037 and 0049). The amount of resources needed to download a file, which may be battery power or time, are calculated depending on the file length, and the data transfer rate of the device. If the amount of resources exceed the amount of resources needed,

the file is downloaded and at least partially executed. The motivation for this combination would be the same as applied to claim 1.

12. As per **claim 10**, Barmettler & Chanut disclose a conditional execution device as applied to claim 1. Barmettler further discloses wherein said services include messages of announcement of services and contents (Column 5, line 60 to Column 6, line 7, the application identifier), the reception module is designed to receive said information associated with said services in said announcement messages of services and the information identification module is designed to extract said information from said service announcement messages. An application identifier is provided to the installation plug-in.

13. **Claim 11**, recites substantially similar limitations to claim 1, and is therefore rejected using the same art and rationale set forth above.

14. **Claim 14**, recites substantially similar limitations to claim 11, and is therefore rejected using the same art and rationale set forth above.

15. **Claim 16**, recites substantially similar limitations to claim 1, and is therefore rejected using the same art and rationale set forth above.

16. Claims **7, 12-13, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barmettler in view of Chanut, in further view of Gosling et al (Patent 6052732).

17. As per **claim 7**, Barmettler & Chanut disclose a conditional execution device as applied to claim 1. Barmettler & Chanut fail to disclose wherein said information

associated with said services includes at least one forced downloading indicator having an activated value and a deactivated value or wherein said selective acquisition decision module is designed to forcibly allow said downloading if said forced downloading indicator has an activated value. However, the examiner maintains that it was well known in the art at the time of the invention to provide forced downloading as taught by Gosling.

In a similar field of endeavor, Gosling discloses the automatic downloading of object viewers. Gosling discloses a configuration file that can be used to bypass user interaction and accept the object viewer (Column 8, lines 42-53).

Therefore, it would have been obvious to one of ordinary skill in the art to include a portion of the configuration file relating to forcibly downloading the application within the application identifier, and to use it in deciding whether or not to download the application as taught by Gosling. The purpose for doing so would be to ensure that the user has the correct application to render the media, without leaving the user a choice.

18. As per **claim 12**, Barmettler & Chanut disclose a device for compiling information messages associated with services, said messages being intended for transmission to users before execution of said associated services, said device including means of incorporating in said messages information concerning computer programs required for the execution of said services, as applied to claim 1 above. Barmettler also discloses wherein said message compilation device is designed to produce messages intended for a conditional execution device (Figure 3, #253, Figure 5, #273-276). Barmettler would inherently include some form of communication necessary to determine which

plug-in or application is necessary. This communication would either be included within the application identifier, a file header, or in a separate identifier with similar function. Any of these three locations would be an obvious variant of one another. Barmettler & Chanut fail to disclose wherein the incorporation means are designed to include in said information at least one forced downloading indicator having an activated value and a deactivated value, said indicator designed to forcibly allow the downloading of said computer programs required if said indicator has an activated value. However, the examiner maintains that it was well known in the art at the time of the invention to provide forced downloading as taught by Gosling.

In a similar field of endeavor, Gosling discloses the automatic downloading of object viewers. Gosling discloses a configuration file that can be used to bypass user interaction and accept the object viewer (Column 8, lines 42-53).

Therefore, it would have been obvious to one of ordinary skill in the art to include a portion of the configuration file relating to forcibly downloading the application within the application identifier, and to use it in deciding whether or not to download the application as taught by Gosling. The purpose for doing so would be to ensure that the user has the correct application to render the media, without leaving the user a choice.

19. **Claim 13**, recites substantially similar limitations to claims 1 and 12, and is therefore rejected using the same art and rationale set forth above.

20. **Claim 15**, recites substantially similar limitations to claim 12, and is therefore rejected using the same art and rationale set forth above.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Balasurbramaniam et al (US 6477550 B1) is cited for detecting the presence of a plug-in, downloading if necessary, and running the plug-in with a browser.

b. Mullaly et al (US 6304909 B1) is cited for calculating download time of a file.

c. Wong et al (US 2002/0007357 A1) is cited for determining the media type of a file, generating a codec class name, determining where to find the codec, and either loading or downloading the codec to decode, decompress, and execute the media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS NELSON whose telephone number is (571)270-7256. The examiner can normally be reached on Monday to Thursday, 9AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on (571)272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRIS NELSON/
Examiner, Art Unit 2193

/Lewis A. Bullock, Jr./
Supervisory Patent Examiner, Art Unit 2193